

Appl. No. 10/090,517
Atty. Docket No. 8866
Response dated 6/18/2004
Reply to Office Action of 2/23/2004
Customer No. 27752

REMARKS

Claims 1-26 are pending in the present application. No additional claims fee is believed to be due.

Rejection Under 35 USC 102 Over Yanagida et al. (US 6,024,941) and Deckers et al. (US 6,582,710).

The Office Action has rejected claims 1-6, 9-11, and 26 under 35 US §102(b) as being anticipated by Yanagida et al. (US 6,024,941). Applicants respectfully traverse this rejection as it would apply to the claims.

The Office Action alleges that Yanagida et al. teach stable cosmetic compositions wherein vitamin A is stable. The compositions further comprise phenol compounds, such as BHT, BHA, or hydroxyl substituted benzophenone; EDTA and other well-known cosmetic ingredients according to table 1, 6-2; examples 2-5, 3-7, 4-4, 4-7, 5-4, and the claims. Yanagida et al define BHT and BHA as oil soluble antioxidants included in the external skin treatment composition as stabilizers. See column 4, lines 12-17. See also, John A. Wenninger et al., CTFA Cosmetic Ingredient Handbook 43-44 (2nd ed. 1992) (attached). Although BHT and BHA are phenols, the present invention requires select preservative materials, which include phenolic or phenolic salt preservative materials. Therefore, Yanagida et al. fail to anticipate Applicants' invention because BHT and BHA are antioxidants rather than preservatives.

Claims 1, 3-6, 9, 10, 14, 16, 18, 19, 22, 24, and 26 have been rejected by the Office Action as anticipated by Deckers et al. (US 6,582,710). Applicants respectfully traverse this rejection as it would apply to the claims.

The Office Action maintains that Deckers et al. teach a cosmetic composition comprising vitamin A and phenol compounds BHA and BHT. The composition further comprises other cosmetic ingredients. Applicants point out that Deckers et al. fail to describe all the elements of Applicants' claimed invention. As discussed previously, BHT and BHA are antioxidants rather than preservatives. The Office Action refers to example 12 of Deckers et al. as anticipatory under 35 U.S.C. 102(e). However, example 12 contains Phenonip among its cosmetic ingredients. According to the Cosmetic

Appl. No. 10/090,517
Atty. Docket No. 8866
Response dated 6/18/2004
Reply to Office Action of 2/23/2004
Customer No. 27752

Toiletry and Fragrance Association's online ingredient database, Phenonip contains phenoxyethanol, methylparaben, ethylparaben, butylparaben and propylparaben. See CTFA On-Line, *Ingredient Database (Dictionary/Handbook)*, Phenonip at <http://www.ctfa-online.org> (last visited May 26, 2004) (attached). This example does not teach each and every element of Applicants' claimed invention because the composition is not substantially free of parahydroxybenzoic acid esters. Therefore, Deckers et al. fail to anticipate Applicants' invention because all the elements of Applicants' claim are not described and the rejection should be withdrawn.

Rejection Under 35 USC 103(a) Over Yanagida et al. (US 6,024,941) in view of Oblong et al. (US 5,939,082) and Bisset et al. (US 5,821,237).

Claims 1-12, 14-24 and 26 have been rejected under 35 USC 103(a) as being unpatentable over Yanagida et al. (US 6,024,941) in view of Oblong et al. (US 5,939,082) and Bisset et al. (US 5,821,237). Applicants respectfully traverse this rejection as it would apply to the claims.

The disclosure of Yanagida et al. does not establish a *prima facie* case of obviousness because it does not teach or suggest all of Applicants' claim limitations (see MPEP 2143.03). The Office Action alleges that Yanagida et al. do not require the presence of parahydroxybenzoic acid ester, or formaldehyde and formaldehyde donating compounds. Oblong et al. teach particular vitamin A derivatives, such as retinyl propionate, and Bisset et al. teach particular preservatives, such as O-phenylphenol and dehydroacetic acid as preservatives for cosmetic compositions. However, none of the references recognize or suggest the potential problem of retinoid degradation over time if used in compositions containing parahydroxybenzoic acid esters. Additionally, Bisset et al. teaches away from Applicants' invention by stating that propylparaben and methylparaben are preferred preservatives. See column 15, lines 43-67 and column 16, lines 1-6.

The Office Action further suggests that although Yanagida et al. do not teach to exclude parahydroxybenzoic acid ester, that Yanagida does not require the presence of parahydroxybenzoic acid ester, and that a person of ordinary skill in the art would find it obvious to make a vitamin A containing cosmetic composition without parahydroxybenzoic acid ester. However, Yanagida et al. do not teach or suggest stable

Appl. No. 10/090,517
Atty. Docket No. 8866
Response dated 6/18/2004
Reply to Office Action of 2/23/2004
Customer No. 27752

cosmetic compounds using a preservative selected from the group consisting of phenols, phenol salts, and mixtures thereof in combination with vitamin A. Yanagida et al. do use the phenol compounds, BHT and BHA, but these materials are antioxidants rather than phenol preservatives as discussed above. Furthermore, a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. See *In re Zurko* 111 F.3d 887, 890 (Fed. Cir. 1997). Yanagida et al. do not teach or recognize the problem of retinoid degradation when combined with parahydroxybenzoic acid esters, which is the problem identified and solved by Applicants' invention. Yanagida et al. do not suggest to someone skilled in the art that parahydroxybenzoic acid ester should be excluded from compositions comprising a retinoid. Therefore, Applicants contend that the claimed invention is unobvious over Yanagida et al. in view of Oblong et al. and Bisset et al. and that the rejection should be withdrawn.

Appl. No. 10/090,517
Atty. Docket No. 8866
Response dated 6/18/2004
Reply to Office Action of 2/23/2004
Customer No. 27752

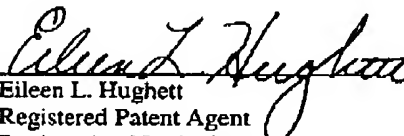
Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. 102 and 35 U.S.C. 103. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application and allowance of Claims 1-12, 14-24 and 26.

Respectfully submitted,

B. S. Resch

By 
Eileen L. Hughett
Registered Patent Agent
Registration No. 34,352
(513) 626-2127

June 18, 2004
Customer No. 27752